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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,739	09/14/2000	Jeffrey D. Ollis	D-2340	9031

7590

10/12/2005

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EXAMINER
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THOMPSON, MARC D

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/661,739

Applicant(s)

OLLIS, JEFFREY D.

Examiner

Marc D. Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9,11,12 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 is/are allowed.
- 6) ☒ Claim(s) 1-9,11,12,14,15 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Applicant response received on 6/16/2005 has been entered into record.
2. Claims 1-9, 11-12, and 14-17 are now pending.

#### ***Priority***

3. This application claims priority to provisional application 60/156,248, filed 9/27/1999.
4. The effective filing date for the subject matter defined in the pending claims in this application which have support in the provisional application is 9/27/1999.

#### ***Drawings***

5. The Examiner contends that the drawings submitted on 12/22/2002 are acceptable for examination proceedings.

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-8 and 14-15 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. Claims 1, 14, and 15 recite "a/the system user" (Lines 5, 6) and later references "the user's language" (Line 12). It is unclear whether the "system user" equates solely to "the user" whose language is specified, or whether there is insufficient antecedent basis for this latter limitation in the claim. The "user characteristics" are seemingly related to the system user, but it is indefinite whether one or more other "users" are required for proper interpretation of the

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claim. All user(s) must be properly recited and defined in the claims, and hold to a strict labeling/naming convention.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-9, 11-12, 15, and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Osder et al. (U.S. Patent Number 5,493,606), hereinafter referred to as Osder, in view of Martino (U.S. Patent Number 5,805,676), hereinafter referred to as Martino.

11. Osder disclosed a centralized storage for audio prompt files in Column 6, Lines 33-46 (SPINDB). Transfer of prompt files from this remote centralized server to a local storage was taught by Osder, inter alia, in Column 9, Line 65 through Column 10, Line 5. The nature of caching requires cache storage(s) were logically more local than remote, hence, locally stored prompt files. User-defined element types and constructions were also expressly disclosed in, inter alia, Column 10, Lines 55-67. Naturally, end user client terminal devices were optionally telephony and/or standard computing equipment. See, Osder, inter alia, Column 1, Lines 14-33, and Column 8, Lines 37-56. Osder specifically recited the use of system user language designation in profile(s) for the system user, controlling the transfer of information relating to that value; this was one of the main purposes of the invention. See, inter alia, Column 3, Line 48 through Column 4, Line 4.

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12. While Osder disclosed the invention substantially as claimed, Osder did not expressly recite user client devices operating to specify which (subset of) files to transfer from remote stores. While it may be argued that user(s) and network application caches specified information relating to the type of data stored, e.g., language preference, and customized element/prompt construction(s), which was derived from user input and logically grouping prompt elements together (inter alia, Column 3, Line 48 through Column 4, Line 4, Column 8, Lines 17-56), Osder did not expressly disclosed user selection of particulars effecting transfer and local storage of files.

13. Osder utilized database (15) (SPINDB) for which details of specifics regarding the specific implementation of this database were omitted. This would have motivated one skilled in the art to search the related database arts for teachings relating to implementation of a database which was used by the Osder system

14. In the art of telephone prompt database operation, Martino disclosed the distribution of data files, including subsets of the entirety, to one or more application specific databases located at differing logical localities to various network components. See, inter alia, Column 9, Lines 19-30, and Column 10, Lines 27-38. Further, Martino specifically disclosed the use of user database(s) as well as remote central database usage. See, inter alia, Column 22, Lines 16-30. The abstract also disclosed the provision for local storage of data streams (i.e., prompt elements and constituent portions) used for user interaction. In short, the system provided, among other things, the use of distributed database(s), including local storage sections, in a menu system using voice, text, and other types of data through modular construction of dynamically generated prompts on various types of computing equipment,

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including phones, and a number of modified embodiments of the disclose system. See, inter alia, Abstract, and Columns 23-24. Importantly, Martino also disclosed the use of forms which were populated with data according to the specification of the form. Martino also provided a truly generalized form generation specification to allow artisans to completely customize output. This customization inherently involved dictation of which services were allowed to particular user(s). See, inter alia, Column 20, Lines 52-67, providing security, and Column 21, Lines 24-32, and Column 22, Lines 54-62, thus equating to “system user subscribed to telecommunication services” as claimed. After all, each customized transaction was tailored to the user utilizing the system’s ability to provide menus; menus in an environment relating to telecommunication services would inherently been based upon information relating to available services specified in a system user profile.

15. It would have been obvious to one of ordinary skill in the art to modify the teachings of multi-lingual prompt management for network applications as provided by Osder with the distributed database aspects used in a network application providing prompt and menu delivery, presentation, and construction as provided by Martino in order to provide local storage for distributed storage, caching, addressing, and retrieval of menu prompt elements. See, inter alia, Osder, Column 3, Lines 55-60, and Martino, Column 10, Lines 27-29.

16. Since the combination of Osder and Martino disclosed all the limitations of the claimed invention as broadly set forth, claims 1-9, 11-12, 15, and 17 are rejected.

***Allowable subject matter***

17. Claim 16 is allowed. Claim 14 would be allowable if modified to overcome issues regarding 35 USC 112, Second Paragraph set forth above.

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18. The prior art of record does not fairly suggest or disclose the provision for the use of user characteristics which includes a specified location of a system user to effect the transfer of a plurality of prompt/announcement user-specified subset of files associated with user-specific characteristics, where these various types of files are further organized in a centralized storage server with respect to said user characteristics, and the transference of the user-specified subset of files to a telecommunications device physically located in close proximity to the system user. This functionality is supported in the present specification, inter alia, at Page 5, Line 25 through Page 6, Line 30. Simply, the physical location of the user is never discussed as connected to the transfer of prompt subsets to client devices.

***Response to Arguments***

19. The arguments presented by Applicant in the response to the final Office action mailed 1/13/2005, received on 6/16/2005, are not considered persuasive.

20. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

21. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

22. Additionally, it should be noted that the prior indication of allowable subject matter is no longer claimed. Claims 10 and 13, previously indicated as allowable, are no longer pending. Applicant distributed constituent parts of these indicated allowable claims into different

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independent claims and asserts allowability without any discussion, factual basis, or evidence.

Absolutely no discussion of the merits of any of the claimed invention are provided in the response, including lacking to clarify indefinite issues raised in prior action(s), and how the current amendments obviate pending rejection(s). This type of minimal, piecemeal, and incremental modification of the claimed invention has hindered advancement of prosecution for multiple actions. It is suggested that Applicant provide a fully qualified position, detailed description and discussion of the claimed invention and how it differs from the prior art applied and of record, in order to isolate reasoning for potential allowance of the claims.

23. Applicant has had multiple opportunities to amend the claimed subject matter, and has generally failed to modify the claim language to distinguish over the prior art of record by clarifying or substantially narrowing the claim language. Applicant apparently intends that a broad interpretation be given to the claims and the Examiner has adopted such in the present and previous Office action rejections. See, inter alia, *In re Prater and Wei*, 162 USPQ 541 (CCPA 1969), and MPEP § 2111. Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows multiple interpretations and meanings which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly as reasonably possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Examiner has interpreted the claims with scope parallel to the Applicant in prior responses, and reiterates the need for the Applicant to clearly, distinctly, and uniquely claim the invention.



Lastly, the current claims infer coverage breadth which is inconsistent with breadth of the disclosure and are not found distinguishable above the prior art of record.

***Conclusion***

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc D. Thompson whose telephone number is 571-272-3932. The examiner can normally be reached on Monday-Friday, 9am-4pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, David Wiley can be reached at 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned has recently changed, and is now 571-273-8300.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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